

### **REMARKS**

In the Office Action issued on November 18, 2003, the Examiner objected to claim 37 as being dependent on a canceled base claim. The Examiner rejected claims 36 and 40 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,558,599 to Bethune ("Bethune"). The Examiner also rejected claims 39, 41 and 42 as being unpatentable over U.S. Patent No. 6,328,920 to Uchiyama et al. ("Uchiyama") in view of Bethune. The Examiner indicated claims 1-4 and 8-31 were allowed and that claims 37 and 38 would be allowable if rewritten in independent form.

Claim 37 has been amended to recite dependence from claim 36. Applicants therefore request withdrawal of this objection. Claims 1-4, 8-31, and 36-42 remain pending in the application.

#### **I. Claims 36 and 40 are not Anticipated by Bethune**

The Examiner rejected claims 36 and 40 under 35 U.S.C. §102(b) as being anticipated by Bethune. Claim 36 has been amended to recite that the mold cavity has a substantially fixed volume throughout the steps of the process. Bethune discloses a process wherein the mold is opened during the cooling of the thermoplastic material. See, e.g., abstract and col. 4, lines 20-28. The opening of the mold necessarily changes the volume of the mold cavity. Because Bethune fails to disclose a process wherein the mold cavity is kept substantially fixed, it fails to anticipate claim 36 and dependent claim 40, which contains all the limitations of base claim 40.

#### **II. Claims 39, 41, and 42 are not Rendered Obvious Over Uchiyama in View of Bethune**

The Examiner also rejected claims 39, 41 and 42 as being unpatentable over Uchiyama in view of Bethune. Applicants respectfully traverse.

Neither Bethune nor Uchiyama, either alone or in combination, discloses or suggests a method of forming an in-mold coated article as claimed wherein the mold cavity volume remains substantially fixed throughout the process as required by claim 39. In addition, neither Bethune nor Uchiyama, either alone or in combination, discloses or suggests a molding and coating process as claimed wherein the two mold members remain a fixed distance relative to one another throughout the molding and coating process as required by claims 41 and 42.

In this respect, and as discussed above, Bethune discloses a process wherein the mold is opened during the cooling of the thermoplastic material. The opening of the mold necessarily changes the volume of the mold cavity. Likewise, this opening necessarily changes the distance of the two mold members relative to one another. Uchiyama also discloses a process wherein the mold is opened after injection of the first plastic and prior to the injection of the second material. See, e.g., col. 3, lines 24-34. As with Bethune, this opening of the mold necessarily changes the volume of the mold cavity as well as changing the distance of the two mold members relative to one another. Thus, any proposed combination of Bethune and Uchiyama would also fail to disclose or suggest such a method of forming an in-mold coated article.

### **CONCLUSION**

Based on the above amendments and comments, it is respectfully submitted that the application is in condition for allowance. An early indication thereof is respectfully requested.

Respectfully submitted,

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